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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/504,812	08/13/2004	Mark Dominic Jackson	227	2113

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PATENT DEPARTMENT
MACROVISION CORPORATION
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EXAMINER	
PYZOCHA, MICHAEL J	
ART UNIT	PAPER NUMBER
2137	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/504,812	JACKSON ET AL.	
	Examiner	Art Unit	
	MICHAEL PYZOCHA	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *47-88* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *47-88* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/4/05,7/11/05,12/27/05,4/30/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 47-88 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 47-63 and 81-88 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 47-63 relate to an "application file" and a "storage device" that only contains data. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the mean of 35 USC §101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 47-51, 53-68, 70-78, and 81-88 are rejected under 35 U.S.C. 102(b) as being anticipated by Hogan (US 5699434).

As per claims 47, 48, 50, 63, 64, 66, 67, 77, 78, and 81, Hogan discloses information and control data for an application incorporated in the application file; and wherein, to provide copy protection for the application, DSV data patterns are incorporated in the application file, DSV data patterns being located in the information incorporated in the application file, and DSV data patterns also being located in the control data in the application file, wherein the control data is incorporated in the application file or is incorporated in a header to the application file (see column 6 lines 42-57).

As per claims 49, 51, 61, 62, 65, 68, and 82, Hogan discloses the DSV data patterns are incorporated in locations of the application file which are normally accessed upon use of the application file (see column 6 lines 45-48).

As per claims 53, 70, and 83, Hogan discloses the DSV data patterns are chosen to cause DSV problems for optical disc writers (see column 5 lines 10-20).

As per claims 54, 71, and 84, Hogan discloses the DSV data patters are chosen to ensure that the DSV has a significant absolute value (see column 6 lines 40-50).

As per claims 55, 72, and 85, Hogan discloses the DSV data patterns are repeated patterns of values (see Fig 4 and column 6 lines 42-67).

As per claims 56, 73, and 86, Hogan discloses the size of DSV data patterns is a predetermined amount (see column 6 lines 58-67)

As per claims 57, 74, and 87, Hogan discloses the DSV data patterns are arranged to produce a DSV which has a rapid rate of change (see column 6 lines 20-25).

As per claims 58, 75, and 88, Hogan discloses the DSV data patterns are arranged to produce a DSV which has a substantial low frequency component (see column 6 lines 42-57).

As per claims 59 and 76, Hogan discloses areas of data containing only zeros are incorporated in the application file in one or more areas located before and after areas containing the DSV data patterns (see column 5 lines 52-63).

As per claim 60, Hogan discloses the information in the application file comprises one or more of: audio data, numerical data, text data, video data, graphics data, program data, animation data, and any other data (see column 6 lines 42-57).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 52 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan.

As per claims 52 and 69, Hogan fails to explicitly disclose the application file has control data incorporated in the application file or in a header to the application file, and further comprising including at least one pointer or offset in the control data which points to the location of the DSV data patterns in the application file. However, Official Notice is taken that at the time of the invention one of ordinary skill in the art would use a pointer or offset to point to the location of the DSV pattern. Motivation to do so would have been that these are common and well-known methods used.

7. Claims 79 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 78 above, and further in view of Owa et al. (US 20030002866).

As per claims 79 and 80, Hogan fails to explicitly disclose performing a mastering process utilizing an encoder controlling a laser beam.

However, Owa et al. teaches such a mastering method (see paragraph [0095]).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the mastering method of Owa et al. in the Hogan system.

Motivation to do so would have been to reproduce the content on the disk (see paragraph [0095]).

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 of patent #7334268 contain every element of claims 47-88 of the instant application and as such anticipate claims 47-88 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hogan and Saito disclose methods of copy protection using DSV.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PYZOCHA whose telephone number is (571)272-3875. The examiner

can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJP

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2137